



Attorney Docket No.: 5649-915

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Cho et al.
Serial No.: 10/060,486
Filed: January 30, 2002

Examiner: L. Kilday
Group Art Unit: 2829

For: METHODS OF FORMING SPIN ON GLASS LAYERS BY CURING
REMAINING PORTIONS THEREOF

February 3, 2003

BOX NON-FEE AMENDMENT
Commissioner for Patents
Washington, DC 20231

**PROVISIONAL ELECTION OF SPECIES AND REQUEST FOR
WITHDRAWAL OF REQUIREMENT**

Sir:

This Provisional Election is submitted in response to the Election/Restriction Requirement mailed January 2, 2003. The Election/Restriction Requirement specified that Applicants were required to "pick one embodiment that includes one element from each of the groups A-M." *Election/Restriction Requirement, page 4, paragraph 2 (emphasis added)*. The Election/Restriction Requirement also asserts that "no claim is generic." *Election/Restriction Requirement, page 5*.

In response, Applicants provisionally elect the embodiment denoted by A1B1C1D1E1F1G1H1I1J1K1L1M1 with traverse. Applicants also respectfully request withdrawal of The Election/Restriction Requirement as 1) the assertion that no claims are generic is incorrect; 2) it creates an unfair burden on Applicants by possibly requiring Applicant to file an excessive number of divisional applications; 3) it does not comply with the standards of restriction/election practice set-out in the MPEP; and 4) it would not be a burden for the Examiner to search all of the claims together.

The assertion that no claim is generic is incorrect. The present application includes 14 claims: 1 independent claim and 13 claims which depend from Claim 1. Accordingly, independent Claim 1 is generic. Applicants respectfully request that the Examiner acknowledge the generic nature of Claim 1.

The present application includes a total of 14 claims: 1 independent claim and 13 dependent claims. However, the election/restriction requirement has required the

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Applicant to elect an embodiment which includes at least 13 distinct aspects disclosed in the specification. Respectfully, it appears to Applicants that the Examiner is proposing to examine such narrow aspects of the present application that no meaningful examination can be provided without requiring the Applicant to file an inordinate number of divisional applications. For example, as understood by Applicants, the Examiner's analysis of the different aspects found in the Applicants disclosure appears to indicate that Applicants 3 ½ page detailed description discloses 1,382,400 distinct species. Applicants respectfully submit that such an approach to examination of the present application would be neither efficient nor fair to Applicants.

Moreover, as understood by Applicants, the election/restriction is requiring Applicants not to select claims for examination, but to redraft the claims to include all of the aspects selected from the specification by the Examiner. In particular, the embodiment suggested for election by the Examiner includes recitations not included in any of the claims separately. For example, the election/restriction states that an exemplary election of embodiment would be denoted by A1B1C1D1E1F1G1H1I1J1K1L1M1, where each combination of a letter and a number denotes selection of a particular aspect from each of the groups outlined in the election/restriction. The Examiner goes on to suggest that the above election would result in examination of a claim including the following recitations:

...removing SOG layer to expose the integrated substrate by etching SOG layer through the mask pattern to form a recess in H₂O gas, where the SOG thickness is adequate to prevent oxidation of IC structure during the second curing process, etching for 20 – 50 seconds using a CG etchant, forming a polysilicon mask, on a gate electrode with a stopper layer of Silicon nitride, where the SOG layer is silicate that is applied by spin coating, using a Al₂O₃ hard mask, and etching the SOG to not expose the IC. *Election/Restriction Requirement, pages 4-5.*

Accordingly, Applicants respectfully submit that the approach taken by the Examiner exceeds the reasonable boundaries and purposes behind restriction practice as it focuses examination on recitations not present in any one pending claim.

The election/restriction requirement also does not comply with the standards of restriction/election practice set-out in the MPEP. The election/restriction requirement states that "Applicant is required to pick one embodiment that includes one element from each of the groups A-M." *Election/restriction requirement, page 4.* Applicant is unable to locate any section of the MPEP which authorizes the approach to election/restriction requirement practice taken by the Examiner. To the contrary, the MPEP actually requires applicants to elect a species, not one embodiment:

809.02(a) Election Required

...

Action as follows should be taken:

(A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

(C) **Applicant should then be required to elect a single disclosed species....MPEP section 809.02(a) (emphasis added).**

As shown above, the MPEP actually requires an Applicant to elect a disclosed **species, not an embodiment** as suggested by the Examiner. If the Examiner chooses to change the present election/restriction requirement to require Applicants to elect a single disclosed species, Applicants alternatively elect the species illustrated in Figures 3-6 of the present application for prosecution on the merits (which Claims 1-14 read on).

Furthermore, Applicants respectfully submit that a search and examination of the entire application can be made without placing a serious burden on the Examiner, which requires that the Examiner to examine the entire application on the merits. In particular, according to M.P.E.P. § 803:

If the search and examination of an entire application can be made without serious burden, the examiner **MUST** examine it on its merits, even though it includes claims to independent or distinct inventions. *(emphasis added)*.

Moreover, the MPEP requires that the Examiner provide reasons for the requirement:

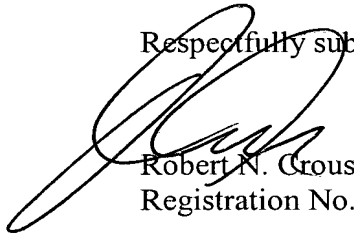
GUIDELINES

Examiners **must provide reasons and/or examples to support conclusions**, but need not cite documents to support the restriction requirement in most cases.

Applicants are unable to locate any basis for the requirement in the election/restriction requirement. Applicants respectfully request the withdrawal of the election/restriction requirement and the examination of Claims 1 – 14 on the merits.

If any extension of time for the accompanying response or submission is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee that may be required or credit any refund to our Deposit Account No. 50-0220.

Respectfully submitted,


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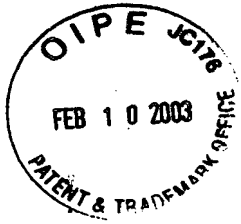


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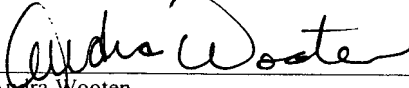
In re: Cho et al.
Serial No.: 10/060,486
Filed: January 30, 2002
Page 5



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX NON-FEE AMENDMENT, Commissioner for Patents, Washington, DC 20231, on February 3, 2003.


Andrea Wooten
Date of Signature: February 3, 2003